

REMARKS

Claim Rejections

Claims 1, 4, 7, 8 and 9 are rejected under 35 U.S.C. § 102(a) as being anticipated by Sanna (JP 2003/257234). Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanna in view of Partridge (U.S. 6,118,645). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanna. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sanna in view of Moeller et al. (U.S. 5,241,449).

Drawings

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

Abstract of the Disclosure

Applicant is submitting a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. Entry of the substitute Abstract of the Disclosure is respectfully requested.

Substitute Specification

As required by the Examiner, a Substitute Specification is enclosed, along with a marked-up copy of the original specification indicating the changes made thereto by the Substitute Specification. No "new matter" has been added to the original disclosure by the Substitute Specification. Entry of the Substitute Specification is respectfully requested.

New Claims

By this Amendment, Applicant has canceled claims 1-9 and has added new claims 10-14 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a desk lamp with a function of generating negative ions comprising: a lamp body (410) having a lamp base, a lamp arm, and a lampshade; a negative ion generator (420) having an air outlet plane located on an interior wall of the lamp base; and a fan (430) connected to the negative ion generator, wherein the negative ion generator and the fan are connected to the interior wall of the lamp base.

Other embodiments of the present invention include: the fan has a plurality of connecting portions (432) connecting the fan to the lamp base through the negative ion generator; the negative ion generator has a plurality of connecting portions (423) located on opposing sides of the air outlet plane; the air outlet plane is connected to the interior wall of the lamp base; and the lampshade defines a light region, the air outlet plane is located on an interior of a top of the lamp base and positioned toward the light region.

The primary reference to Sanaa teaches a desk lamp having a negative ion generator located in a lampshade.

Sanaa do not teach a negative ion generator having an air outlet plane located on an interior wall of the lamp base; a fan connected to the negative ion generator; the negative ion generator and the fan are connected to the interior wall of the lamp base; nor do Sanaa teach the air outlet plane is connected to the interior wall of the lamp base.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Sanaa does not disclose each and every feature of Applicant's new claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent

a specific showing of these features, Sanaa cannot be said to anticipate any of Applicant's new claims under 35 U.S.C. § 102.

The secondary reference to Partridge teaches a self-balancing bipolar air ionizer and is cited for teaching an ionizer having a fan.

Partridge do not teach a negative ion generator having an air outlet plane located on an interior wall of the lamp base; the negative ion generator and the fan are connected to the interior wall of the lamp base; nor do Partridge teach the air outlet plane is connected to the interior wall of the lamp base.

The secondary reference to Moeller et al. teaches a radon decay product remover (20) connected to a light bulb (14).

Moeller et al. do not teach a negative ion generator having an air outlet plane located on an interior wall of the lamp base; a fan connected to the negative ion generator; the negative ion generator and the fan are connected to the interior wall of the lamp base; nor do Moeller et al. teach the air outlet plane is connected to the interior wall of the lamp base.

Even if the teachings of Sanaa, Partridge, and Moeller et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: a negative ion generator having an air outlet plane located on an interior wall of the lamp base; the negative ion generator and the fan are connected to the interior wall of the lamp base; nor does the combination suggest the air outlet plane is connected to the interior wall of the lamp base.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to

attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Sanaa, Partridge, or Moeller et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Sanaa, Partridge, nor Moeller et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.


Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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